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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/349,517 07/08/99 MCDONALD

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WM01/0507

EXAMINER

CALVE, J

ART UNIT

PAPER NUMBER

2164

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/349,517

Applicant(s)
MCDONALD, Russell W. et al

Examiner
First Last

Art Unit
1234



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 8, 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jul 8, 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Art Unit: 2164

DETAILED ACTION

Drawings

1. The drawings are objected to because Figure 5h, disclosed on page 5, line 8 of the specification is missing. Correction is required.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: late close penalty (34e) (Figure 4c), social security number (36h) (Figure 4c), buyer's employment (36i) (Figure 4d), co-buyer's employment (36j) (Figure 4d), Next button 40) (Figure 4e), screen display (50) (Figure 5d), lien holder (52a), amount owed (52b), priority (52c), detailed program info tab (72e), display (681) (disclosed in association with Figure 8l, which is missing). Correction is required.

Specification

3. The abstract of the disclosure is objected to because of the use of legal phraseology (e.g., "computer processor means", "storage means", and "means for processing data"). Correction is required. See MPEP § 608.01(b).
 - a. The reference to selecting loan info tab (32) on page 9, line 18 is ambiguous, as Figure 4a discloses tabs 32a-e.
 - b. The references to "figure 5" on page 11, line 1, and "figure 4" on page 11, line 8, are ambiguous, as the application discloses only figures 4a-h and Figures 5a-g.
 - c. The references to "figures 4 and 5" on page 12, line 2 and page 15, line 17, are ambiguous, as the application discloses only Figures 4a-h and Figures 5a-g.

Art Unit: 2164

d. The reference to "figure 8" on page 18, line 22, is ambiguous, as the application discloses only figures 8a-h.

e. The reference to "figure 8l" on page 22, line 24 is confusing, as the specification does not disclose such a figure.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 1, line 5, the limitation "initializing" is vague and indefinite. It is unclear what structural or functional limitation is intended.

b. The recitation of "first", "second", "third", "fourth", and "fifth means" for "initializing" and "processing data" is vague and indefinite. It is unclear what particular feature(s) of the disclosed invention is (are) being recited.

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

Art Unit: 2164

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-5 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tengal et al, U.S. patent 5,940,812.

Tengal et al disclose a first processor/CPU (112), storage/memory means (110), first means for initializing the storage medium (e.g., terminals 102-107), second data processing means (e.g., for credit information) (e.g., column 2, line 40 et seq), third data processing means (e.g., for first portion of borrower attributes) (e.g., column 2, line 39 et seq), fourth means generating a loan application (e.g., column 3, line 20 et seq), fifth data processing means (e.g., column 3, line 20 et seq), primary input and output hardware (e.g., terminals, 102-107, 11, 113), remote computer (e.g., 109), communication link (e.g., Figure 1). Tengal et al are deemed to disclose inherently a fifth data processing means (e.g., column 3, line 20 et seq). To the extent that Tengal et al could be interpreted otherwise, it would have been obvious to one of ordinary skill in the art at the time of the invention to generate legally-required disclosure documents as part of the application generation process in order to comply with statutory requirements as part of the loan settlement process (e.g., Truth in Lending Act). Little patentable weight is given to the preamble recitation of a data processing system for managing the origination of a mortgage loan *by a loan originator* (emphasis added). In order to limit the claim, the preamble must be "essential to point out the invention defined by the claim." *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951); *see also* MPEP 2111.02. Further, it is noted that in claims directed to articles, apparatus, and systems, the preamble must limit the structure of the article or apparatus to be given weight. *See*

Art Unit: 2164

In re Stencel, 4 USPQ2d 1071 (Fed. Cir. 1987). Moreover, it is noted that Tengal et al are deemed to disclose inherently a system for managing origination of a mortgage loan, which system can be used by a loan originator. See, e.g., *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986) (“[u]nder the principles of inherency,” a claim is anticipated “if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim”); see also MPEP 2112.02 and discussion therein.

Tengal et al also disclose sixth means for transferring loan application (e.g., column 2, line 60 et seq), seventh means (e.g., column 3, line 20 et seq).

8. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Dykstra et al, U.S. patent 5,930,776.

Dykstra et al disclose a first processor/CPU (10), storage/memory means (at 10) (e.g., column 2, line 15 et seq), first means for initializing storage medium (e.g., terminals 26, 28, 30), second data processing means (e.g., for credit information 14, 16) (e.g., column 2, line 32 et seq), third data processing means (e.g., column 2, line 5 et seq; column 2, line 30 et seq), fourth and fifth loan application generating means (e.g., column 7, line 15 et seq). Dykstra et al are deemed to disclose inherently a fifth data processing means (e.g., column 7, line 15 et seq). To the extent that Dykstra et al could be interpreted otherwise, it would have been obvious to one of ordinary skill in the art at the time of the invention to generate legally-required disclosure documents as part of the application generation process to comply with statutory requirements (e.g., Truth in

Art Unit: 2164

Lending Act). Little patentable weight is given to the preamble recitation of a data processing system for managing the origination of a mortgage loan *by a loan originator* (emphasis added).” In order to limit the claim, the preamble must be “essential to point out the invention defined by the claim.” *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951); *see also* MPEP 2111.02. Further, it is noted that in claims directed to articles, apparatus, and systems, the preamble must limit the structure of the article or apparatus to be given weight. *See In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). Moreover, it is noted that Tengel et al are deemed to disclose inherently a system for managing origination of a mortgage loan, which system can be used by a loan originator. *See, e.g., W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986) (“[u]nder the principles of inherency,” a claim is anticipated “if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim”); *see also* MPEP 2112.02 and discussion therein.

Dykstra et al also disclose sixth and seventh means for transferring loan application (e.g., Figure 1; column 3, line 35 et seq).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Fraser et al, U.S. patent 5,995,947.
- b. DeFrancesco et al, U.S. patent 5,878,403.

Art Unit: 2164

- c. Norris, U.S. patent 5,870,721.
- d. Larche et al, U.S. patent 5,765,144.
- e. IBM Technical Disclosure Bulletin, vol. 34, issue 10A, pp. 408-409, March 1992.
- f. "Truth in Lending Act -- Regulation Z," 3 pages, found at

"<http://www.mortgagemart.com/regz.html>" on April 26, 2001.

- g. Truth in Lending Disclosure Statement, Form RegZD (03/95), found at

"<http://nt.mortgage101.com/web/pdf/til.pdf>" on April. 26, 2001.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim Calve, whose telephone number is (703) 308-1884. The examiner can normally be reached on Monday through Friday from 6:45 am to 6:45 pm. If the examiner is unavailable, the examiner's supervisor, Vincent Millin, may be reached at (703) 308-1065. The fax number for this organization is (703) 305-9051/9052. Any inquiry of a general nature should be directed to the receptionist at (703) 305-3900.

JPC

April 26, 2001


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